

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITES STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TROY J. LIEBL and TODD G. HANSON

Appeal No. 2005-2479
Application 09/944,108¹

ON BRIEF



Before McKELVEY, MacDONALD, AND NAPPI, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is a decision on appeal from a final rejection of claims 1 and 3-22.

We AFFIRM.

¹ Filed September 4, 2001. Appellants claim benefit under 35 U.S.C. § 120 of applications 08/702,751 and 08/702,803 both filed November 1, 2000 and provisional application 60/240,812 filed October 17, 2000. The real party in interest is SPX Corporation. (Appeal brief, page 1)

DECISION ON APPEAL

A. Introduction

1. Appellants appeal from a final rejection entered January 27, 2004.
2. The Examiner has rejected claims 1 and 3-22 under 35 U.S.C. § 103.
3. Claim 2 has been canceled.
4. The issue before the Board is whether Appellants have established that the Examiner erred in rejecting claims 1 and 3-22 based on 35 U.S.C. § 103.

B. Findings of fact

The following findings of fact are believed to be supported by a preponderance of the evidence.

The invention

1. The invention relates to a method and apparatus for displaying monitored data on a hand-held display apparatus (Appellants' specification at page 1, lines 8-10).
2. More particularly, the displayed data relates to a motor vehicle and the hand-held display apparatus is an automotive analyzer (specification at page 1, lines 10-13).
3. Function keys, a direction key, and action keys control the displaying of the data (specification at page 13, line 15, through page 14, line 4).
4. The control of the display is analogous to the operation of the scroll key or a mouse in a Windows environment (specification at page 14, lines 4-6).
5. The invention can be understood by reference to Figures 2 through 5 of the drawings of Appellants' specification.

6. Fig. 2 is a screen shot of the visual display in which a list of sensors and switches is shown (specification at page 12, lines 1-2).

7. Fig. 3 is a screen shot of the visual display in which selected sensors are highlighted with enlarged characters (specification at page 12, lines 4-6).

8. Fig. 4 is a screen shot of the visual display in which a sensor has been selected for graphing and the graph includes a zoomed-in portion (specification at page 12, lines 7-9).

9. Fig. 5 is a screen shot of the visual display in which a sensor has been selected for graphing, the graph includes a zoomed-in portion, and the graph employs a trigger line 11 (specification at page 12, lines 10-13).

Prosecution history

10. The application filed September 4, 2001, contained claims 1-20.

11. On January 27, 2004, the Examiner entered a final rejection.

12. Appellants filed an appeal brief on August 11, 2004.

13. The Examiner mailed an Examiner's Answer on November 18, 2004.

14. Appellants did not file a reply brief.

Examiner's rejection

15. Claims 1 and 3-22 were rejected under 35 U.S.C. § 103 as being unpatentable over Gurne et al (Gurne), U.S. Patent 6,181,992, issued January 30, 2001, based on an application filed April 28, 1995.

16. Gurne is prior art vis-à-vis applicants under 35 U.S.C. § 102 (e).

17. During prosecution, Appellants made no attempt to antedate (37 CFR § 1.131) Gurne.

Gurne

18. Figures 1 and 2 describe a hand held unit 10, which connects to a car 12 and a master station 14 via cables 16, 18. The hand held unit 10 has specialized hardware and software on board for communicating with the various controllers on the car (col. 3, lines 44-48).

19. The hand held unit 10 is said to be capable of operating as a scan tool, volt-ohm meter, and data-logging unit by itself without requiring support from the master station (col. 3, lines 48-51).

20. The hand held unit 10 includes a display screen 20 and a keypad 22 (col. 4, lines 1-2).

21. The key pad includes (1) four function keys 26, (2) four directional arrow keys 27 used to parse through character strings and step through logic sequences, (3) two enter keys 28 to indicate a command is to be entered, (4) ten alphanumeric keys 29 for entering letters, numbers and characters, and (5) eight special function keys 30 used for responding to queries and the like (col. 4, lines 10-16).

22. The hand held unit 10 includes an expansion slot 31, approximately 2 inches long and 1/4 inch wide, is adapted to receive conventional PCMCIA [Personal Computer Memory Card International Association] card memory expansion boards. The memory expansion cartridges are useful when using the hand held unit as a data logger (col. 4, lines 24-28).

23. When in scan tool mode, the hand held unit communicates with the vehicle 12 via the communication cable 16 (col. 6, lines 15-17).

24. The hand held unit 10, once connected into a communication bus in the vehicle via an interface, sends commands to the engine controller and receives information back. (col. 6, lines 30-33).

25. When in scan tool mode, the hand held unit communicates with the vehicle 12 via the communication cable 16 (col. 6, lines 15-17).

26. As shown in FIG. 5, upon powering up the hand held unit 10, a technician is presented with an initial screen configuration menu display 60 providing a variety of options and function keys. From the initial screen configuration, the technician can select any menu item 62 by pressing the corresponding number 64 or can invoke a function such as (1) "help" 66, (2) "screen toggle" 68, (3) "illuminate back light display" 76 and (4) "stop" 72 by pressing the function F1 through F4 keys 74-80, respectively. It should be noted that providing the generic key face labels "F1" through "F4" 82-88 while providing the function describer in the form of an icon located above the key allows the key pad to be freely configurable through software (col. 6, lines 36-47).

27. To select item number one, "vehicle diagnostics" 62, the technician can depress the numeral one on the key pad to move the highlight curser bar to the first item. Similarly, the technician could use the directional arrow keys 27 to scroll the highlight bar to item number one. Once the highlight bar is highlighting, or pointing to, the first item, the technician depresses the enter key to indicate that the first item is the desired item to be acted upon (col. 7, lines 6-13).

28. The hand held unit is said to be able to monitor hundreds of different parameters on the vehicle. For example, (1) an engine controller can provide information regarding fuel-air ratio, (2) a transmission controller can provide transmission oil temperature, (3) an anti-lock brake controller can provide wheel speeds and (4) a body controller can provide information on whether lamps are burned out or doors are opened. Thus, it is said that it is possible for the hand held tool to gather, from a variety of sources, information necessary to diagnose problems (col. 10, lines 6-15).

29. The hand held unit has been provided with the capability for the technician to develop customized reading templates for gathering diverse information quickly and efficiently. To develop a customized template, the technician simply selects the menu item for using and storing templates. By selecting this menu item, the hand held unit is placed in a programming mode of sorts (col. 10, lines 22-25).

30. To define customized templates, the technician enters the customization mode and simply selects from lists those parameters the technician wishes to display in the customized template. After selecting the items and building the template, the technician can store a selected customized template in the memory of the hand held unit by selecting the store option and entering an appropriate template identifier string (col. 10, lines 40-47).

31. During later operations, the technician can retrieve the customized template by selecting it from the list of available templates (col. 11, lines 6-8).

32. The master station 14 is designed to work in cooperation with the hand held unit in performing sophisticated diagnostic procedures and the like (col. 12, lines 38-40).

33. The user interface of the master station appears similar to that of FIG. 8. As can be seen, the user interface is both graphic and textural in nature, where the highlight bar can be

moved between items to select the desired action. To move the highlight bar, the technician can use the keys of the keyboard or, if the hand held unit is connected to the master station, can use the key pad on the hand held unit. Similar to selecting items on the hand held unit, the technician can parse through screens using directional arrow and paging keys.

34. As shown in figures 12 and 13, on the master station, the captured data is displayed graphically as well as numerically. Moreover, in the event that many parameters have been monitored, certain of the parameters can be displayed graphically while the remainder of the parameters are displayed textually. Similar to the concept of using templates for selecting the data to be logged, the master station has templates that define which variables are displayed graphically as charts and which variables are displayed simply textually as numbers or as logic states (col. 16, lines 30-39).

35. Figures 12 and 13 each show a list of measurements, descriptions and values arranged in an order and labeled as MAP, TPSv, RPM, etc.

36. Figure 13 shows a display with a generated first graphical representation of said selected data over time (MAP VACUUM), a produced second graphical representation (TPS VOLTS), and simultaneously displaying the first graphical representation and second graphical representation on said display screen.

37. On the master station, the technician can retrieve predetermined templates or can define customized templates (col. 16, lines 39-41).

38. Since the data displayed (on the master station) represents a snapshot in time, the display cursor, represented as a dashed line 120 on the data graphs, indicates the point in time for which the variables are being displayed. Thus, the variables being displayed textually represent the value of those variables corresponding to the point in time where the cursor lies. The cursor

position is represented as a relative time value from the beginning of the window, and is useful when attempting to determine the elapsed time between events or occurrences (col. 16, lines 41-50). [We note that although the indicator (120) is found in figure 12, the dashed line 120 is not actually shown in any figures.]

39. When the technician does not find a desirable template, the technician selects the menu screen for building templates, as shown logically in FIG. 15. Once in the template building screen, the technician moves the highlight bar from item to item, selecting those desired to be displayed during the dynamic data display operation. As shown in FIG. 16, the technician has selected some very specialized parameters, such as cam shaft position and crankshaft position, because it is believed there is a problem with the timing belt alignment (col. 18, lines 40-49).

Additional prior art cited by the Board

40. We cite the following prior art: Rosenberg et al (Rosenburg), U.S. Patent 5,790,819, issued August 4, 1998.

41. Rosenberg is prior art vis-à-vis applicants under 35 U.S.C. § 102 (b).

Rosenburg

42. Rosenberg describes graphical interfaces to display and analyze one-dimensional data sets (col. 1, lines 9-11).

43. One-dimensional data sets include data sets consisting of values of one or more time-varying functions at each of a number of different times (col. 1, lines 16-18).

44. One of the problems said to be present in the prior art is that a one-dimensional data set may be so large that it is not possible to display all of it in full detail in the available

display area (col. 1, lines 35-37). Rosenburg is said to solve this problem with a mechanism for zooming in a display of a one-dimensional data set (col. 4, lines 6-10).

45. Figure 10(B) illustrates an example of the zoom mechanism of Rosenburg (col. 4, lines 60-61).

46. Figure 10(B) shows a graphical interface with a first graphical representation of said selected data over time, a second graphical representation produced by varying a time axis of the first graphical representation of said selected data over a portion of said data and simultaneously displaying the first graphical representation and second graphical representation on said display screen.

47. The application program 111 may control the update of the data displayed on the graphical interface 105 (col. 5, lines 16-17).

C. Discussion

1. Independent Claim 1

Appellants argue at page 17 of the brief that Gurne “provides no teaching or suggestion of arranging an order of measurements, descriptions and values displayed in a displaying step as recited in claim 1 of the present application.” We disagree.

In our opinion, the argued limitation of “arranging an order . . .” is taught by the Gurne reference. Figures 12 and 13 of Gurne describe a list of measurements, descriptions and values arranged in an order (MAP, TPSv, RPM, etc.) (Fact 35). The list necessarily requires the step of arranging the order of the list. It appears to this Panel that Appellants are reading into the claim subject matter on arranging not appearing in the claim but found at page 22 of the specification.

At page 22, Appellants disclose that the technician (an end user) can arrange the order of the sensors and switches in any desired order (on the display). As claimed, the arranging is not limited to “the technician or end user” nor is it limited to “any desired order.” Rather, “arranging the order” is broadly claimed so as to include the system designer arranging the order in which the items will be displayed in the displaying step. We note that Appellants own disclosed method necessarily requires that the system designer arrange some order in which to display the list. Otherwise, there would not be an order for the technician to change or reorder (specification at pages 2, 4, and 18).

In view of the above discussion, it is our view, that since Gurne teaches the argued limitation, Gurne describes all that is claimed. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of obviousness.” **Jones v. Hardy**, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also **In re Fracalossi**, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); **In re Pearson**, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Given that the broadest reasonable interpretation of the “arranging the order” limitation includes the system designer arranging the order in which the items will be displayed, the Appellants’ argument fails to establish any error in the Examiner’s **prima facie** case. Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103 for the reasons as set forth above.

2. Dependent Claims 3-11

Claims 3-11 depend from claim 1. Appellants fail to separately argue claims 3-11. Rather, at page 18 of the brief, Appellants merely state the features of each of these claims and allege, without explaining why, that the additional features render each claim separately

patentable. The rules in effect at the time the brief was filed specifically address the weight to be given the statements and allegations presented by Appellants. See 37 CFR § 1.192 (c) (7):

Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

See also 37 CFR § 41.37 (c) (1) (vii) (2005, which became effective September 13, 2004 (69 Fed. Reg. 49960 (Aug 12, 2004))):

A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Appellants have not discussed why the evidence would support a holding that claims 3-11 are patentable apart from claim 1. Therefore, we will sustain the Examiner's rejection of claims 3-11 under 35 U.S.C. § 103 as standing of falling with the patentability of claim 1.

3. Independent Claim 12

Appellants argue at page 19 of the brief that in Gurne "there is no teaching or suggestion of 'a graphics program for generating a first graphical representation of said selected data over time, said graphics program further producing a second graphical representation by varying a time axis of the first graphical representation of said selected [data] over a portion of said data and simultaneously displaying the first graphical representation and second graphical representation on said display screen' as recited in claim 12 of the present application."

In our view, the claimed subject matter as a whole, including the argued limitation would have been obvious under 35 U.S.C. § 103. Figure 13 of Gurne describes a display with a generated first graphical representation of said selected data over time (MAP VACUUM), a produced second graphical representation (TPS VOLTS), and simultaneously displaying the first graphical representation and second graphical representation on said display screen (Fact 36).

Gurne differs in that it does not describe that the first and second graphical representations are related by varying a time axis of the first graphical representation of said selected data over a portion of said data. However, Rosenburg describes “a graphics program for generating a first graphical representation of said selected data over time, said graphics program further producing a second graphical representation by varying a time axis of the first graphical representation of said selected data over a portion of said data and simultaneously displaying the first graphical representation and second graphical representation on said display screen” (Facts 46 and 47).

Given the combined disclosures of Gurne and Rosenburg, it would have been obvious to implement Rosenburg’s relationship between the first and second graphical representation in the Gurne display of plural graphical representations in order to get the benefit of seeing the full detail of a selected portion of the data set as taught by Rosenburg (Fact 44). Appellants have done nothing more than use known techniques for their intended purpose to achieve an entirely expected result.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103 for the reasons as set forth above.

4. Dependent Claims 13-16 and 22

Claims 13-16 and 22 depend from claim 12. Appellants fail to separately argue claims 13-16 and 22. Rather, at page 20 of the brief, Appellants merely state the features of each of these claims and allege, without explaining why, that the additional features render each claim separately patentable. The rules in effect at the time the brief was filed specifically address the weight to be given the statements and allegations presented by Appellants. See 37 CFR § 1.192 (c) (7):

Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellants have not discussed why the evidence would support a holding that claims 13-16 and 22 are patentable apart from claim 12. Therefore, we will sustain the Examiner's rejection of claims 13-16 and 22 under 35 U.S.C. § 103 as standing of falling with the patentability of claim 12.

5. Independent Claims 17 and 21

With respect to claims 17 and 21, Appellants merely restate the argument presented with respect to claim 12. We have found that argument to be unpersuasive. Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above with respect to claim 12.

6. Dependent Claims 18-20

Claims 18-20 depend from claim 17. Appellants fail to separately argue claims 18-20. Rather, at page 21 of the brief, Appellants merely state the features of each of these claims and allege, without explaining why, that the additional features render each claim separately patentable. The rules in effect at the time the brief was filed specifically address the weight to be given the statements and allegations presented by Appellants. See 37 CFR § 1.192 (c) (7):

Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellants have not discussed why the evidence would support a holding that claims 18-20 are patentable apart from claim 17. Therefore, we will sustain the Examiner's rejection of claims 18-20 under 35 U.S.C. § 103 as standing of falling with the patentability of claim 17.

D. Decision

For the reasons given, the decision of the Examiner rejecting claims 1 and 3-22 under 35 U.S.C. § 103 is affirmed.

E. Options for further proceedings

We designate that part of our affirmation (claims 12-22) which includes newly cited prior art as a new ground of rejection under 37 CFR § 41.50(b) (2005).

37 CFR § 41.50(b) provides that, “[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record ...

Should the Appellant elect to prosecute claims 12-22 further before the Primary Examiner pursuant to 37 CFR § 41.50 (b) (1), in order to preserve the right to seek review under

35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection of claims 1-11, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection of claims 1-11 is overcome.

If the Appellant elects further prosecution before the Examiner and further prosecution does not result in allowance of the application, abandonment or a second appeal, this application should be returned to the Board of Patent Appeals and Interferences for entry of a final decision with respect to the affirmed rejection of claims 1-11, including any action on any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

37 CFR § 41.50(b)

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Administrative Patent Judge

Allen R MacDonald
ALLEN R. MacDONALD
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